

Notice of Allowability

Application No.

09/874,350

Examiner

Chih-Min Kam

Applicant(s)

PACKARD ET AL.

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/18/07.
2. ☒ The allowed claim(s) is/are 1-7 and 9-38.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying Indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

DETAILED ACTION

Status of the Claims

1. Claims 1-7 and 9-38 are pending.

Applicants' amendment filed on May 18, 2007 is acknowledged. Applicants' response has been fully considered. Claims 13, 17, 32 and 35 have been amended. Thus, claims 1-7 and 9-38 are examined.

Sequence Listing

2. A copy of a substitute Sequence Listing filed electronically on May 18, 2007 is acknowledged, and CRF has been entered.

Withdrawn Informalities

3. The previous objection to the specification regarding some sequences in Table 4 not consistent with those in Sequence Listing is withdrawn in view of applicant's submission of a corrected Sequence Listing, and applicant's response at page 10 of the amendment filed May 18, 2007.

Withdrawn Claim Objections

4. The previous objection to claims 13, 17-20, 32 and 35 is withdrawn in view of applicant's amendment to the claim, and applicant's response at page 10 in the amendment filed May 18, 2007.

Withdrawn Claim Rejections - 35 USC § 112

5. The previous rejection of claims 13 and 32 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendment to the claim, and applicant's response at page 10 of the amendment filed May 18, 2007.

Examiner's Amendment

An **Examiner's Amendment** to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Tom Hunter on July 30, 2007.

Examiner's Amendment to the Specification:

Please replace the paragraph of the specification beginning at page 1, lines 4-9 with the following paragraph:

This is a continuation-in-part of PCT/US00/24882, filed on September 11, 2000, designating the United States, which is a continuation-in-part of U.S. Application Serial No. 09/394,019, filed on September 10, 1999, now U.S. Patent 6,936,687, which is a continuation-in-part of PCT/US98/03000, filed on February 20, 1998, designating the United States, which is a continuation-in-part of U.S. Application Serial No. 08/802,981, filed on February 20, 1997, now U. S. Patent No. 6,037,137, all of which are herein incorporated by reference in their entirety for all purposes.

Examiner's Amendment to the Claims:

Claims 36-38 have been amended as follows:

36. (Currently amended) The composition of claim ~~24~~ 35, wherein said hydrophobic group is Fmoc.

37. (Currently amended) The composition of claim ~~24~~ 35, wherein said hydrophobic group is Fa.

38. (Currently amended) The composition of claim ~~24~~ 35, wherein said hydrophobic group is attached to the amino terminus of the molecule.

The following is an **Examiner's Statement of Reasons for Allowance**: The following reference appears to be the closest art to the claimed invention. Komoriya *et al.* (U.S. Patent

Art Unit: 1656

6,037,137) teach a fluorogenic composition for the detection of the activity of a protease having the formula cited in claim 1, where P is a peptide comprising a protease binding site for the protease, and F¹ and F² are fluorophores. The 6,037,137 patent has the same inventors as the instant application, and a terminal disclaimer has been filed over the patent. Therefore, the claims are allowable over the art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Bragdon can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Primary Patent Examiner



CHIH-MIN KAM
PRIMARY EXAMINER

CMK

July 30, 2007